

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks and accompanying Declaration under 37 CFR 132.

Claims 5 and 10-26 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Accordingly, claims 1-4 and 6-9 are pending in the present application, of which claim 1 is independent.

Claims 1-4 and 7-8 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,742,680 to Wilson (“Wilson”) in view of U.S. Patent No. 6,128,735 to Goldstein et al. (“Goldstein”).

Claims 6 and 9 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson in view of Goldstein and further in view of U.S. Patent No. 5,381,481 to Gammie et al. (“Gammie”).

The Examiner is requested to withdraw Goldstein as an applicable reference in rejecting pending claims 1-4 and 6-9 as being unpatentable for at least the following reasons.

As stated in the accompanying Declaration under 37 CFR 132, U.S. Patent Application No. 09/587,932 and Goldstein were, at the time the invention of U.S. Patent Application No. 09/587,932 was made, owned by Motorola, Inc. Further, Goldstein issued as a patent on October 3, 2000 after the filing date of U.S. Patent Application No. 09/587,932, and Goldstein qualifies as prior art only under subsection (e) of 35 U.S.C. 102. However, subject matter developed by another person, which qualifies as prior art only under subsections (e), (f), (g) of 35 U.S.C. 102 shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See

35 U.S.C. 103(c) and MPEP §706.02(I)(2). Thus, Goldstein is disqualified as an applicable reference in the rejection of pending claims 1-4 and 6-9 as being unpatentable. The Declaration is necessary and was not earlier presented in that Goldstein was first applied in the Final Office Action of July 18, 2008.

For at least the foregoing reasons and the reasons stated below, withdrawal of the rejection and allowance of this application it is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S._, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would

have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-4 and 7-8

Claims 1-4 and 7-8 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson in view of Goldstein. This rejection is respectfully traversed for the above-described reasons for disqualifying Goldstein as an applicable reference in the rejection and for at least the following additional reasons.

Claim 1 recites:

A method of providing data, the method comprising:

storing a first set of encryption data associated with a first data stream wherein the first data stream includes a first number of services of at least two different service types;

...

storing a second set of encryption data associated with a second data stream wherein the second data stream includes a second number of services of the at least two different service types that is different from the first number of services . . .

Wilson fails to teach or suggest the above recited features. Instead, Wilson discloses selecting one of a plurality of simultaneously received encrypted broadcast satellite (DBS) signals for decryption and viewing. Wilson at Abstract, lines 1-4. The Office Action at page 4 cites lines 16-27 in column 6 of Wilson as showing a number of services of at least two different service types. However, while the cited portion of Wilson discloses MPEG video and MPEG audio, Wilson fails to teach or suggest that a first data stream includes a first number of services of at least two different service types and a second data stream includes a second number of services that is different from the first number of services.

More specifically, since Wilson discloses that a selected one of the plurality of simultaneously received encrypted broadcast satellite (DBS) signals is processed for MPEG video and audio (See Wilson at column 6, lines 1-04, 16-27), each selected DBS signal has two services (that is, MPEG video and audio). Further, since Wilson fails to teach or suggest that a selected DBS signal is different from other DBS signals other than perhaps in program content, the services available for a DBS signal is not different in number from the services available for another DBS signal of Wilson as

recited in claim 1. Thus, for at least the above-discussed reasons, Wilson fails to teach or suggest that a first data stream includes a first number of services of at least two different service types and a second data stream includes a second number of services that is different from the first number of services.

Goldstein fails to overcome the above-discussed deficiencies of Wilson. Instead, Goldstein discloses that a single encryption engine may be iteratively used for multiple encryption. Goldstein at column 8, lines 22-24. However, Goldstein fails to teach or suggest the above recited features of claim 1.

Thus, for at least the foregoing reasons, the proposed combination of Wilson and Goldstein fails to teach or suggest all of the features of claim 1 and its dependent claims 2-4 and 7-8. The Office Action has thus failed to establish that claims 1-4 and 7-8 are *prima facie* obvious. The Examiner is therefore respectfully requested to withdraw the rejection of claims 1-4 and 7-8 and to allow these claims.

Claims 6 and 9

Claims 6 and 9 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson in view of Goldstein and further in view of Gammie. This rejection is respectfully traversed for the above described-reasons for disqualifying Goldstein as an applicable reference in the rejection and for at least the following additional reasons.

Claims 6 and 9 depend from independent claim 1. Thus, for at least the same reasons set forth earlier with respect to claim 1, Wilson and Goldstein, either alone or in combination, fail to teach or suggest that a first data stream includes a first number of services of at least

two different service types and a second data stream includes a second number of services that is different from the first number of services, as recited in claim 1.

Gammie fails to cure the above-discussed deficiency of Sellers. While the Office Action at page 6 relies on Gammie to show features of Data Encryption Standard recited in dependent claims 6 and 9, Gammie fails to teach or suggest the above-recited features of claim 1.

Thus, for at least the foregoing reasons, the proposed combination of Wilson, Goldstein and Gammie fails to teach or suggest all of the features of claim 1 and its dependent claims 6 and 9. The Office Action has thus failed to establish that claims 6 and 9 are *prima facie* obvious. The Examiner is therefore respectfully requested to withdraw the rejection of claims 6 and 9 and to allow these claims.

Conclusion

During a telephone conference of September 16, 2008 with the undersigned, the Examiner Pich discussed a possibility of another rejection based on a new reference. While proper rejections should be made in the application, Applicants point out that the present application has been pending for 8 years and respectfully request that, if another rejection is possibly made in this case, that efforts be made to put forward the best reference so that the prosecution of this application can be concluded reasonably promptly without any further delay.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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